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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/890,078

Jorg Schreilber

BEIERSDORF-724-WCG

5707

7590

05/17/2002

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 05/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/890,078

Applicant(s)

SCHREILBER, JORG

Examiner

Gina C. Yu

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Priority Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 1 and 2 are objected to because, while the claims set forth a plurality of elements or steps, each element or step of the claim is not separated by a line indentation. See 37 CFR 1.52(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "in particular" renders the claim indefinite. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. In the present instance, claim 1 recites the broad recitation the "constituents" of the oil phase, and the

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claim also recites "the phospholipids and the O/W emulsifiers and optionally W/O emulsifiers" which is the narrower statement of the range/limitation.

Similarly, in claim 2, the phrase "for example" renders the claim indefinite. Claim 2 recites the broad limitation on a process "during which viscosity is increased", and the claim also recites "for example, the gels are obtained", which is the narrower statement of the limitation.

The term "low" in claims 1 and 2 is a relative term which renders the claim indefinite. The term "low" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 1 and 2 contain inconsistent terminology to describe the emulsion types. The terms "oil-in-water", "O/W", and "W/O" are inconsistently used through out the claims.

The remaining claims are rejected as depending on indefinite base claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-6 and 9 are rejected under 35 U.S.C. 103(a) as being obvious over Diec et al. (WO 9628132 A2, English abstract Derwent Acc. No. 1996-433505) in view of Friedman et al. (US 6113921) ("Friedman").

Diec teaches microemulsion gels comprising an oil phase of chiefly non-volatile components, water phase, polyethoxylated compounds as emulsifiers, and optionally

W/O emulsifiers. Examples are viewed as deodorant formulations. See instant claim

4. UVA absorbers and antioxidants are disclosed on p. 43- 45. See instant claims 5 and 6. The English translation does not disclose using lecithin or the process of making the emulsion. The full translation of the patent will be provided upon availability.

Friedman teaches oil-in-water microemulsions comprising phospholipid, nonionic surfactants, and active agent(s), and method to prepare thereof. See col. 2, line 16 – col. 3, line 60; Example 1.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the microemulsion gels in Diec by adding the phospholipid as suggested by Friedman, because of the expectation of successfully producing non-irritating composition comprising naturally-derived emulsifiers. The ingredients in the instant claims are well known in microemulsions art, and nothing

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unexpected is seen in combining the conventional ingredients. It is noted that since instant claim 1 is a product-by-process claim, the determination of the patentability in that claim is based on the composition itself. See MPEP § 2113.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman et al. (US 6113921) ("Friedman") in view of Schröder et al. (US 5298240) ("Schröder") and Hill (US 5623017).

Friedman, as discussed above, teaches oil-in-water microemulsions comprising phospholipid, nonionic surfactants, and active agent(s), and method to prepare thereof. See col. 2, line 16 – col. 3, line 60; Example 1. See also col. 1, line 57 – 67 and col. 4, lines 29 – 41 for the teaching that microemulsions are transparent or translucent. See claims 1 and 2. The reference also teaches gelling agents may be used to increase viscosity of the composition. See col. 7, lines 44 – 56. While the invention in Friedman is directed to pharmaceutical compositions, the reference suggests using formulating cosmetic compositions. See col. 6, lines 7 – 11 (teaching cosmetic ingredient is mixed with the oily excipients). The reference fails to teach the specific cosmetic application of the invention.

Schröder teaches hair care compositions in the form of a microemulsion gel. See abstract. The reference also teaches that clear microemulsions have been used for skin and hair. See col. 1, lines 51 – 58.

Hill teaches clear silicone microemulsion gel composition, applicable in hair care, cleansers, sunscreens and antiperspirants. See col. 1, line 16 – col. 2, line 58.

Given the general teaching of transparent microemulsion gel compositions used in skin or hair cosmetic applications in Schröder and Hill, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the microemulsions in Friedman into the cosmetic compositions well known in the art.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
May 6, 2002


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